

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Filing Date: October 15, 1998
Patent No.: 6,228,074
Issue Date May 8, 2001
Date:

PETITION FOR RECONSIDERATION UNDER 37 C.F.R. § 1.378(e)

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.378(e) for reconsideration of Examiner's Decision on Petition, dated November 21, 2011 on Patentee's Petition to accept the delayed payment of maintenance fees due on the above-identified patent, on an expedited basis, whereby the patent will not be considered as having been expired. This request for reconsideration is filed on behalf of Stephen Almeida, who is the inventor of U.S. Patent No. 6,228,074, the above-identified patent (the Petition Patent).

Patent No. 6,228,074 was issued on May 8, 2001. The first maintenance fee was paid in accordance with the provisions of 37 C.F.R. § 1.362(e)(1). The second maintenance fee could have been paid with the surcharge set forth in 37 CFR 1.362(e)(3) as late as June 8, 2009. Since the second maintenance fee was not paid, Patent No. 6,228,074 expired after midnight on June 8, 2009.

A petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The Office of Petitions in its Decision On Petition (“Decision”) acknowledged receipt of the payment of the petition fee of \$400.00. The required maintenance fee of \$1,425.00 and the surcharge set forth in 37 C.F.R. § 1.20(i)(1) was charged to counsel’s deposit account. This petition for reconsideration is accompanied by a petition fee of \$400.00 as set forth in 37 C.F.R. § 1.17(f).

DECISION ON PETITION

The Patent Office held that the showing of record was inadequate to establish unavoidable delay. The Patent Office stated that the Petitioner has provided insufficient evidence to substantiate a claim of docketing error. The Patent Office dismissed Petitioner’s petition and stated that the Petitioner must show that, at both Brown Rudnick and Seyfarth Shaw, there was in place a business routine for performing the clerical function of transferring the data from Brown Rudnick to Seyfarth that could reasonably be relied upon to avoid errors in its performance.

The Decision indicated that Petitioner must identify the clerical error that was the cause of the delay at issue and explain how, despite the existence of a business routine for performing

this clerical function that could reasonably be relied upon to avoid errors in its performance, said error nevertheless occurred. The Patent Office has requested that Petitioner provide evidence that a reliable system was in place for transferring this data. The Patent Office stated that such a showing must include an indication as to why the system failed to provide adequate notice that a maintenance fee was due.

SHOWING OF UNAVOIDABLE DELAY

The Petitioner, as requested in the Decision, has attached to this petition declarations from two relevant employees of Brown Rudnick, with first hand knowledge related to the transfer of files from Brown Rudnick to Seyfarth Shaw. The attached declarations of Mark S. Leonardo (Exhibit E), who at all times relevant was the Chair of the Intellectual Property Department at Brown Rudnick and Keith Schultz (Exhibit F) supplement the previously submitted declarations of Stephen Almeida (Exhibit A), June Kaps (Exhibit B), Edwin Colon (Exhibit C) and John Serio (Exhibit D). Petitioner has attached to this petition the previously submitted declarations and attachments for the convenience of the Examiner.

These additional declarations, when taken with the previously submitted declarations and attachments, clearly establish that Brown Rudnick, the law firm that prosecuted the application from which the above-identified patent matured and had without incident paid all maintenance fees due, had received instructions to transfer the files associated with the Petition Patent. Brown Rudnick, because of inadvertent clerical error in the transfer of docketing information, unavoidably failed to transfer at least the requested electronic docketing information to Seyfarth Shaw that has a reliable docket system to ensure timely payment of maintenance fees. The inadvertent docketing information transfer error by Brown Rudnick and corresponding failure to transfer relevant physical files, caused the docket records at Seyfarth Shaw to not reflect the maintenance fees that were due for the Petition Patent. As a result of the clerical error that

caused a docketing information transfer error, docketing information was not received by Seyfarth Shaw causing the matter of the Petition Patent to not be entered in Seyfarth Shaw's docketing system and the correspondence address to not be updated at the Patent Office.

The record in this Petition to Revive is now complete, as the Patent Office has requested, and clearly reflects that Brown Rudnick inadvertently failed to transfer, due to a clerical error, at least the electronic docketing information to Seyfarth Shaw, despite written instructions from the client. Petitioner respectfully submits that Seyfarth Shaw also did not receive the client requested physical files as established by the previously submitted declarations of Serio, Kaps and Colon. The file transfer protocol in place that was developed by experienced patent practitioners and Kaps, an experienced patent docketing clerk with 17 years of experience, was dependant upon the receipt of at least a physical file and/or its electronic docketing information.

In developing Seyfarth's file transfer protocol, redundant transfer of both physical and electronic docketing information was aimed at ensuring that transfer errors would be avoided. The file transfer protocol developed by Seyfarth was reasonably based upon a system that accounted for failures in transfer of either the physical file or the docketing information.

The supplemental declarations, of Leonardo and Schultz, along with the previously submitted declarations and the Patent Maintenance Fee records at the United States Patent and Trademark Office (USPTO) establish the unavoidable nature of the failure to pay the maintenance fee for the Petition Patent.

More specifically:

1. It is established that both Brown Rudnick and Seyfarth Shaw have a complete and reliable system for docketing deadlines pertaining to USPTO proceedings, including deadlines for payment of maintenance fees. Both patent docketing systems include a well known patent

docketing software program from Computer Packages Inc. called “CPI” (Kaps Decl. ¶10; Leonardo Decl. ¶26). This state of the art software program used by both firms calculates future deadlines from information entered into the program and produces reminders of those deadlines.

2. During the transfer of physical and electronic files from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw contracted with CPI, who worked with both Brown Rudnick and Seyfarth Shaw, to retrieve all electronic docketing information related to all clients that requested transfer of their files from Brown Rudnick to Seyfarth Shaw (Kaps Decl., ¶¶14–16; Schultz Decl. ¶11).

3. The transfer of over 700 active files and several thousand inactive files was coordinated between the docketing and file room personnel of both Seyfarth Shaw and Brown Rudnick. To ensure redundancy and best practices for the transfer of numerous clients from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw’s docketing clerk June Kaps, who has extensive experience in docketing matters, (Kaps Decl., ¶¶5–7) worked with experienced personal within the file room of Brown Rudnick (Schultz Decl. ¶6-9; Leonardo Decl. ¶ 11-13) .

4. Brown Rudnick’s file room at the time of transfer was managed by Deborah Hopkins who had significant experience in file room management. Ms. Hopkins was assisted by Keith Schultz who had significant experience in IT matters. (See Leonardo Decl. ¶11).

5. Ms. Kaps had specific procedures in place to ensure that every physical file received by Seyfarth Shaw would be properly entered into Seyfarth Shaw’s docketing system and that the transfer of these files would be confirmed by the electronic data dump of docketing information performed by CPI (Kaps Decl., ¶15). As a result of Client transfer requests and in order to ensure that the clients’ matters were protected, Brown Rudnick worked with Seyfarth Shaw and Brown Rudnick and Seyfarth Shaw’s patent docketing software company, CPI, to transfer the

client's electronic docket entries to Seyfarth as requested by client transfer instructions. (See Leonardo Decl. ¶14).

6. Brown Rudnick and Seyfarth Shaw believed that the steps taken during the transfer of files had redundancy to ensure that important client matters would be protected in the form of the transfer and receipt of physical files, but also the transfer and receipt of corresponding electronic docket entries. (See Kaps Decl., ¶15) (See Leonardo Decl. ¶15).

7. To Petitioner's knowledge and belief, Brown Rudnick's docket system reflected the due dates for the maintenance fees for the Petition Patent, as it had previously paid the 3.5 year maintenance fee for the Petition Patent.

8. Upon receipt of the Decision on Petition, Serio contacted Mark Leonardo of Brown Rudnick seeking declarations requested by the Examiner (See Exhibit E, Leonardo Declaration ¶20).

9. Based upon information received during Serio's call to Mark Leonardo, Brown Rudnick conducted an investigation of the file transfer related to the Expired Patent, the Petition Patent and other related files of Almeida ; (See Exhibit E, Leonardo Declaration ¶22).

10. During the course of Brown Rudnick's investigation, it determined that they possessed two non-patent related files for this client, but did not find any physical files related to the Expired Patent or Petition Patent. According to Brown Rudnick's records, they believe that relevant files were transferred along with numerous unrelated patent files on or about May 24, 2007 to Seyfarth. However, Brown Rudnick could not locate any receipt for the transfer of Almeida's files to Seyfarth; (See Exhibit E, Leonardo Declaration ¶22).

11. As a result of Brown Rudnick's investigation, they determined that they received a reminder notice from the USPTO concerning the Expired Patent, and they believed that they received a reminder notice from the USPTO concerning the Petition Patent. Brown Rudnick believed that both expiration notices received by them were forwarded to Seyfarth, as is Brown

Rudnick's customary practice, however, they only have evidence of transmittal of the second notice concerning the Expired Patent; (See Exhibit E, Leonardo Declaration ¶24).

12. As a further result of Brown Rudnick's investigation, they confirmed making arrangements to have the client docket entries on the CPI system for the Expired Patent and Petition Patent transferred to Seyfarth, but in doing so, the transfer only effected a transfer of selected files other than the Expired Patent and the Petition Patent. During the course of Brown Rudnick's investigation it was determined that the transferred selected files concerned non-patent matters for the client and contained no docket information regarding the Expired Patent and the Petition Patent. (See Exhibit E, Leonardo Declaration ¶25).

13. The transfer of the electronic docket entries apparently only effected a transfer of selected Client files concerning matters 7 and 9 and not all Client matters, as the Client had instructed. During the course of Brown Rudnick's investigation, regarding the circumstances giving rise to the expiration of the Petition Patent, it was determined that the selected electronic files attempted to be transferred, matters 7 and 9, concerned non-patent matters for the Client, which contained no docket information. Despite a diligent investigation, Keith Schultz of Brown Rudnick is unsure why a request for the electronic transfer of docketing information for only selected files was sent to CPI, for the client. (See Exhibit F, Schultz Declaration ¶11-12)

14. The failure to transfer the electronic docketing information appears to be an honest clerical error that compounded the failure to receive the physical files of relevant to the Petition Patent and the Expired Patent. (See Exhibit F, Schultz Declaration ¶11-12)

In summary, in view of the original Petition to Revive and the present Petition for Reconsideration, the completed record shows that Seyfarth Shaw and Brown Rudnick had reliable docket systems for ensuring timely payment of maintenance fees. As a result of a clerical error, docketing information that was believed to have been transferred by CPI to Seyfarth Shaw was not received. This mistaken belief, caused by a clerical error caused the

required maintenance fee notices to not be processed by Brown Rudnick, and these notices were not forwarded to Seyfarth Shaw as was their customary practice. Seyfarth Shaw, not being in receipt of the physical files from Brown Rudnick or the electronic files via CPI, nor the notice sent by the Patent Office, was not aware of the need to pay these maintenance fees. In other words, the clerical error apparently caused the failure to transfer the electronic docketing information and physical files. If the docketing information had been transferred then all subsequent events leading to non-payment of the 2nd maintenance fee would not have occurred. Thus, the complete record shows an unavoidable delay as to non-payment of the 2nd maintenance fee.

CONCLUSION

Petitioner submits that the record is complete as requested by the Patent Office and a proper showing has been made that the delay in the payment of the maintenance fee due on this Petition Patent was unavoidable due to a clerical error resulting in the failure to transfer docketing information.

Accordingly, acceptance, on an expedited basis, of the unavoidably delayed payment of the maintenance fee due on the Petition Patent is respectfully requested, whereby the patent will not be considered as having been expired.

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 50-2896.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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January 19, 2012
Date: